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09/273,021	03/19/1999	HAROLD W. MILTON JR.	MILT.777	6459
7590 07/07/2010 HAROLD W. MILTON JR. 2430 WINDBROOK RUN BLOOMFIELD HILLS, MI 48304				
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HAROLD W. MILTON JR.

Appeal 2008-005996
Application 09/273,021¹
Technology Center 2100

Before LANCE LEONARD BARRY, ST. JOHN COURTENAY III, and
CAROLYN D. THOMAS, *Administrative Patent Judges*.

THOMAS, *Administrative Patent Judge*.

DECISION ON APPEAL²

¹ Application filed March 19, 1999. The real parties in interest are Harold W. Milton, Jr. and Patent Architect LLC.

² The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Appellant seeks our review under 35 U.S.C. § 134(a) of the Examiner's final decision rejecting claims 1, 3, 10, and 19-28, which are all the claims remaining in the application, as claims 2, 4-9, and 11-18 are cancelled. We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We REVERSE.

The present invention relates to preparing a patent application which is acceptable to and conforms and facilitates the translation and filing in the various jurisdictions of the world. (Spec., 1, ll. 8-10.)

Claim 1 is illustrative:

1. A method of preparing a patent application with a computer comprising the steps of:

storing a document template in a computer program which contains headings equivalent to:

“BACKGROUND OF THE INVENTION

1) Field of the Invention

2) Description of the prior Art

SUMMARY OF THE INVENTION AND ADVANTAGES

BRIEF DESCRIPTION OF THE DRAWINGS

DETAILED DESCRIPTION OF THE PREFERRED EMBODIMENT

CLAIMS

ABSTRACT OF THE DISCLOSURE”;

storing a page break immediately before the “CLAIMS” heading in the computer program;

storing a page break immediately before the “ABSTRACT OF THE DISCLOSURE” heading in the computer program;

storing a footer in the computer program for displaying the attorney file identification on every page of the application;

composing by a user an independent claim in the computer program ending in a clause beginning with the words “characterized by” and reciting and isolating the novelty and preceded by at least one clause reciting prior art elements to the extent necessary to support and provide antecedent basis for the “characterized by” clause;

drafting claims in the computer ultimately dependent upon the independent claim for successively more specifically defining the patentable novelty; and

characterized by storing a duplicate set of all of the claims in the computer program, and creating the description by retrieving the duplicate set of claims under the heading “DESCRIPTION OF THE PREFERRED EMBODIMENT”, searching for each occurrence of the word “said” in the duplicate set of claims copied into the specification, programming the computer program to replace the word “said” with the word “the” in the duplicate set of claims copied into the specification, and editing the duplicate set of claims copied into the specification into grammatically correct sentence structure including adding verbs, and assigning reference numerals for the first time by the steps of storing the element names of the elements in the order recited in the duplicate set of claims, storing successive numbers beginning with a number above the highest Figure number to identify the respective element names, and searching for each occurrence of each respective element name in the order of occurrence in the duplicate set of claims, replacing each respective element name with that respective element name followed by successive ones of said numbers to provide identifying reference numerals for the element names in the order of occurrence in the duplicate set of claims and automatically shifting the reference numerals in response to changing the order of occurrence in the duplicate set of claims.

Appellant appeals the following rejections:

1. Claims 1, 3, 21, 22, and 26 under 35 U.S.C. § 103(a) as unpatentable over Petruzzi (US 6,049,811, Apr. 11, 2000) and Rivette (US 5,754,840, May 19, 1998); and
2. Claims 10, 19, 20, 23-25, 27, and 28 under 35 U.S.C. § 103(a) as unpatentable over Petruzzi, Rivette, and Newman (US 5,774,833, June 30, 1998).

FACTUAL FINDINGS

Rivette

1a. Rivette discloses “[a] system and method for assisting in the preparation of a document, . . . such as a patent or patent application. . . . The system also facilitates editing of the patent application so as to achieve terminology consistency.” (Abstract.)

2a. In Rivette, “the DDMT [document development and maintenance too] 202 determines whether the reference numbers (also called element numbers) contained in the current document have been previously indexed.” (Col. 14, ll. 27-29.)

3a. Rivette discloses that “[t]he element index table 2402 includes a row or record for each reference number. Each record identifies the reference number, the number of hits of the reference number contained in the current document, and the element name associated with the reference number.” (Col. 14, ll. 37-41.)

ANALYSIS

Our representative claim, claim 1, recites, *inter alia*, “assigning reference numerals for the first time by the step of storing the element names of the elements in the order recited in the duplicate set of claims.”

Independent claims 19, 20, 21, and 26 recite similar limitations. Thus, the scope of each of the independent claims includes providing an identifying reference numeral in the order of occurrence.

Issue: Did the Examiner err in finding that the combination of Petruzzi and Rivette, particularly Rivette, discloses providing identifying reference numerals for the element names in the order of occurrences?

The Examiner found that “Rivette teaches an order of occurrence of elements in the description including assigning numerals in the order of the first recitation of the element in an edited duplicate set of claims that created the description.” (Ans. 11-12.)

Appellant contends that Petruzzi “does not suggest the pre-step of copying the claims into the description section before applying reference numerals to element names.” (App. Br. 13.) Appellant further contends that Rivette “does not suggest numbering elements in the order recited in the description let alone automatically re-numbering when the order shifts.” (*Id.*) We agree with Appellant.

Here, the Examiner relies primarily upon Rivette to disclose assigning reference numerals to the element names, however, we find that the Examiner has not provided sufficient evidence in Rivette to show such a feature. For example, Rivette discloses editing an existing patent application so as to achieve terminology consistency (FF 1) by determining whether the reference numbers contained in the current document have been indexed (FF 2). In Rivette, the reference numbers are indexed by the number of hits and the element names associated with the reference number (FF 3). In other words, all indications show that Rivette starts with an application with existing reference numerals and uses these numerals to verify element names consistency within the application.

However, the Examiner has not shown where/how Rivette *assigns* the reference numerals. Instead, the cited portions of Rivette starts with a document with existing reference numerals and looks to edit the document to achieve terminology consistency by searching for the reference numbers, not assigning them.

As such, neither the Examiner nor the cited portions of Rivette explain how reference numerals are assigned. Without more of an explanation from the Examiner to correlate the teachings of Rivette to the claimed “assigning reference numerals for the first time,” we do not see how the cited portions of Rivette correspond to above-noted limitations, as recited in claim 1.

The Examiner bears the initial burden of presenting a prima facie case of obviousness, and Appellant has the burden of presenting a rebuttal to the

prima facie case. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). Here, Appellant's rebuttal is persuasive.

Thus, based on the record before us, we find that the Examiner did err in rejecting claim 1. Accordingly, we reverse the rejections of independent claims 1, 19, 20, 21, and 26 as well as associated dependent claims 3, 10, 22-25, 27, and 28.

DECISION

We reverse the Examiner's § 103 rejections.

REVERSED

rwk

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